

REMARKS

The applicant appreciates the Examiner's thorough examination of the application and requests reexamination and reconsideration of the application in view of the preceding amendments and the following remarks.

The Examiner rejects claims 1-7, 10 and 25-31 under 35 USC §103(a) as being unpatentable over U.S. Patent No. 3,258,595 to *Galante* in view of Japanese Publication 06-141211 to *Sosoya*, and claims 8-9 and 11 under 35 USC §103(a) as being unpatentable over *Galante* in view of *Sosoya* and further in view of U.S. Patent No. 4,794,575 to *Miller*. Merely to advance the prosecution of the subject patent application, the applicant has cancelled claims 1-11 and 25-31 from the subject application through the above amendments. Accordingly, these rejections have been rendered moot.

The Examiner also rejects claims 12, 16-21, 24 and 34 under 35 USC §103(a) as being unpatentable over *Galante* in view of *Sosoya* and further in view of U.S. Patent Publication No. 2003/0007795 to *Grober*, and claims 13-14 and 22-23 under 35 USC §103(a) as being unpatentable over *Galante* in view of *Sosoya*, *Grober* and *Miller*.

Independent 12 of the subject application is directed to a photonic buoy system comprising a buoy including a lengthy hull with a ballast portion of the hull which resides below the waterline and a top portion of the hull which is disposed above the waterline. An optical bench including an imager is located within the top portion of the hull. The optical bench is configured to provide a panoramic view of the horizon. A workstation remote from the hull is responsive to the optical bench and includes a display and image stabilization circuitry for presenting a composite image of the horizon on the display. A transmission cable interconnects the optical bench and the workstation.

The Examiner alleges the combination of *Galante* and *Sosoya* discloses all of the elements of independent claim 12 except for a remote workstation including image stabilization circuitry as claimed by the applicant. The Examiner further alleges that *Grober* discloses a display 18 and image stabilization circuitry 17 for presenting a composite image of the horizon on the display (§0027 of *Grober*), and that it would have been obvious to include an image stabilization circuitry in the remote workstation disclosed by *Galante*.

U.S. Patent Publication No. 2003/0007795 to *Grober* is a continuation-in-part patent application of U.S. Patent Application Serial No. 09/579,723 (now U.S. Patent No. 6,611,662). By definition, a continuation-in-part patent application is an application filed during the pendency of an earlier filed nonprovisional application which adds new matter not disclosed in the earlier nonprovisional application. See MPEP §201.08. Additionally, as stated by the Court of Appeals for the Federal Circuit;

A C-I-P application is different from an original patent application, however, in that it often generates two effective filing dates applicable to different parts of the same patent. New matter in a C-I-P application has a filing date of that C-I-P application. The earlier filing date of the parent application pertains to material in the C-I-P application also disclosed in the prior application.

Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1438, 221 USPQ 97, 106 (Fed. Cir. 1984)(emphasis added).

The Examiner alleges that combining the disclosure in § 0027 of *Grober* of a control panel to remotely control the stabilization and a camera system with *Galante* and *Sosoya* would render the claims unpatentable. However, the disclosure in § 0027 of *Grober* is material that was first introduced in the continuation-in-part application and is not also disclosed in the '723 parent application. Accordingly, as this material was first presented in the continuation-in-part

application, this material is only entitled to the filing date of the continuation-in-part application, which is September 7, 2002. The subject patent application has a filing date of July 27, 2001, which is more than a year before the filing date of the continuation-in-part application. Accordingly, the disclosure of *Grober* referenced by the Examiner cannot be used as a prior art against the subject application.

With this reference removed as prior art, the combination of references cited by the Examiner clearly fails to disclose all of the features of the applicant's independent claims 12 and 34. Accordingly, claims 12-24 and 34 are patentable over the cited references.

Even if it were prior art, *Grober* fails to disclose a workstation remote from the hull including a display and image stabilization circuitry for presenting a composite image of the horizon on the display as claimed by the applicant in independent claims 12 and 34 of the subject application. The image stabilization circuitry of the present invention is used to stabilize the images of the horizon as imaged by the optical bench.

Contrary to this idea, *Grober* discloses remotely controlling the stabilization and camera system (stabilized camera head 4) itself, not the images received from the buoy as claimed by the applicant. Stabilizing the images rather than the buoys themselves obviates the need for complex, expensive, and ineffective gyro-stabilization optic assemblies as taught by *Grober* located on the buoy. See page 10, line 14 – page 11 line 8 of the subject application. Instead, the workstation of the subject invention overcomes the effect of the wave motion on the video signal output by the camera on the buoy.

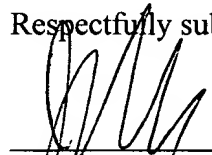
Accordingly, *Grober* fails to disclose image stabilization circuitry remote from the buoy as claimed by the applicant. Therefore, even if *Grober* could be combined with *Galante* and

Sosoya, the combination of references would still fail to disclose all of the elements of the applicant's claimed invention.

Each of the Examiner's rejections has been addressed or traversed. Accordingly, it is respectfully submitted that the application is in condition for allowance. Early and favorable action is respectfully requested.

If for any reason this Response is found to be incomplete, or if at any time it appears that a telephone conference with counsel would help advance prosecution, please telephone the undersigned or his associates, collect in Waltham, Massachusetts, (781)890-5678.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'JDS', is written over a horizontal line.

Jason D. Shanske
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